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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,653	12/21/2000	Michael Hannington	AVERP2808USA	7502
7590	05/27/2004		EXAMINER	
Heidi A. Boehlefeld Renner, Otto, Boisselle & Sklar, P.L.L. Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115			EGAN, BRIAN P	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040524

Application Number: 09/742,653
Filing Date: December 21, 2000
Appellant(s): HANNINGTON, MICHAEL

Heidi Boehlefeld
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 18, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 31-33, 35-40, 42, 43, and 46-77 are pending in the application. Claims 1-30 have been cancelled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on March 18, 2004 (i.e., the amendment Applicant filed on March 15, 2004) has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. However, since the Applicant has grouped the claims such that they should stand or fall together, the only issues on appeal are whether independent claims 31, 59, and/or 60 contain patentable subject matter. Therefore, the changes are as follows:

- A. Whether claims 31 and 59 are obvious over Rusincovitch et al., U.S. Patent 5,676,787.
- B. Whether claims 31 and 59 are obvious over Calhoun et al., U.S. Patent 5,141,790 in view of Rusincovitch et al., U.S. Patent 5,676,787.
- C. Whether claim 60 is obvious over Calhoun et al., U.S. Patent 5,141,790 in view of Torobin, U.S. Patent 4,582,534.

(7) *Grouping of Claims*

The Applicant has stated that the claims shall stand or fall together. Therefore, the rejection of claims 31-33, 35-40, 42, 43, and 46-77 stand or fall together.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,676,787	Rusincovitch et al.	10-1997
5,141,790	Calhoun et al.	8-1992
5,585,178	Calhoun et al.	12-1996
4,582,534	Torobin	4-1986
5,180,635	Plamthottam et al.	1-1993
GB 1,511,060	Unitika Limited et al.	5-1978

The Examiner further notes that the Information Disclosure Statement filed March 11, 2004 has been considered and an initialed copy of the IDS has been filed on record.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 31-33, 35-40, 42, 46-52, 55, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rusincovitch et al. (U.S. 5,676,787). This rejection is set forth in the final rejection filed October 27, 2003.

Claims 31-33, 35-40, 42, 43, 46-52, 55 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (U.S. 5,141,790) in view of Rusincovitch et al. (U.S. 5,676,787). This rejection is set forth in the final rejection filed October 27, 2003.

Claims 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (U.S. 5,141,790) in view of Rusincovitch et al. (U.S. 5,676,787), and further in

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view of Plamthottam et al. (U.S. 5,180,635). This rejection is set forth in the final rejection filed October 27, 2003.

Claims 54 and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (U.S. 5,141,790) in view of Rusincovitch et al. (U.S. 5,676,787), and further in view of Calhoun et al. (U.S. 5,585,178). This rejection is set forth in the final rejection filed October 27, 2003.

Claims 60-62, 66-72, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (U.S. 5,141,790) in view of Torobin (U.S. 4,582,534). This rejection is set forth in the final rejection filed October 27, 2003.

Claims 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (U.S. 5,141,790) in view of Torobin (U.S. 4,582,534), and further in view of GB 1,511,060. This rejection is set forth in the final rejection filed October 27, 2003.

Claims 73 and 75-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (U.S. 5,141,790) in view of Torobin (U.S. 4,582,534), and further in view of Calhoun et al. (U.S. 5,585,178).

(II) Response to Argument

Since the claims stand or fall together, the Examiner will focus solely on the Applicant's arguments with regards to independent claims 31, 59, and 60.

First, with regards to independent claims 31 and 59 and the teachings of Rusincovitch et al. (U.S. 5,676,787), the primary issue of contention is whether Rusincovitch et al. fairly suggest a pattern of non-adhesive material forms embedded into the top release surface of the release

liner wherein the top surface of the non-adhesive material forms is even with or below the plane of the top release surface of the release liner. The Applicant further contends that the process of forming the claimed invention and the substrate in Rusincovitch et al. are material different and it is therefore erroneous to conclude that the non-adhesive forms in Rusincovitch et al. would inherently be fully embedded into the release liner.

The Examiner notes that the Applicant explicitly states on page 18, paragraph [0047] of the specification that “the non-adhesive material may be fully or partially embedded into the release liner.” The Applicant has provided no further distinction within the specification with regards to the positioning of the non-adhesive material and has failed to establish any grounds of unexpected results with regards to positioning a non-adhesive material form even with or below the surface of a release liner versus positioning a non-adhesive material form that is partially embedded into the release liner. The Applicant attempts to counter their position on page 7 of the appeal brief by stating that “the characteristics of air-egress, repositionability, and slidability depend on the position of the non-adhesive material forms relative to the adhesive surface of the adhesive layer.” There is no suggestion within the specification, however, that the results of these aforementioned physical characteristics hinge on the positioning of the non-adhesive forms in the release liner. Rather, the physical properties of the substrate depend on the position of the non-adhesive material forms relative to the adhesive surface, not the release liner. Thus, insofar as the non-adhesive material forms are transferred such that they protrude from the adhesive surface at a sufficient distance to achieve the desired repositionability, slidability, and air-egress of the end product, it is functionally equivalent to place the non-adhesive forms either fully or partially embedded into the release liner.

Rusincovitch et al. (U.S. 5,676,787) explicitly state that “the percent of back surface area occupied by the [pressure sensitive adhesive] as well as the percent of the back surface area occupied by the spacers, the thickness of the spacers, and their heights rising above the place of the adhesive surface are selected to allow the decorative sheet to be slidably movable on the surface of a wall to reposition the sheet and finally to be firmly attached to the wall by application of pressure on the decorative side of the sheet (Col. 9, lines 15-22).” Rusincovitch et al. continue by stating that “[t]ypically, the spacers 18 of Figs. 2B and 4B protrude a height “H” of about 0.05 to about 0.25 mils from the adhesive layer and have a thickness “T” of about 0.05 miles to 0.50 mils (Col. 9, lines 51-54).” Therefore, the teachings of Rusincovitch et al. are consistent with those of the Applicant’s claimed invention, i.e., the physical properties of the substrate depend on the position of the non-adhesive material forms relative to the adhesive surface, not the release liner. Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant’s invention was made to have positioned the non-adhesive material forms either partially or fully embedded into the release liner insofar as the desired physical properties of repositionability, air egress, and slidability are maintained. Thus, the Examiner maintains the use of the CCPA’s reasoning outlined in In re Japkikse, 86 USPQ 70 (CCPA 1980). Just as it would have been obvious to reposition a starting switch on a hydraulic power press since it would not have modified the operation of the device, repositioning of the non-adhesive material forms within the release liner still results in the same end product – an adhesive substrate with protruding non-adhesive forms that assist in slidability and repositionability of the substrate. In either the partially embedded or fully embedded embodiments, the size of the spacers is modifiable to achieve the desired end result. The

Applicant further cites the decision set forth in Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984), i.e., the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness – the prior art must provide a motivation or reason for the worker in the art, without the benefit of applicant's specification, to make the necessary changes in the reference device. It is noted, however, that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). Here, Rusincovitch et al. provide an implied motivation to rearrange the parts of the invention – namely, insofar as the non-adhesive forms protrude at the desired distance, the teachings suggest to one versed in the art that the non-adhesive forms may be positioned such that they are partially or fully embedded into the release liner.

With regards to the Examiner's contention that the process of forming the substrate in Rusincovitch et al. (U.S. 5,676,787) would inherently create a fully embedded non-adhesive material form, the Examiner agrees with the Applicant's contention that there are material differences within the processes, namely, the Applicant forms the substrate at a specific temperature and pressure which Rusincovitch et al. fail to disclose. Therefore, the Examiner withdraws the contention outlined in the Final Rejection that the non-adhesive forms would inherently be even with or below the top surface of the release liner.

Second, with regards to independent claims 31 and 59 and the teachings of Calhoun et al. (U.S. 5,141,790) in view of Rusincovitch et al. (U.S. 5,676,787), the primary issue of contention is once again whether the combination of the aforementioned references fairly suggest to one of

ordinary skill in the art that it would have been obvious to embed the non-adhesive forms such that they are even with or below the top surface of the release liner.

The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). Here, even on face, Calhoun et al. and Rusincovitch et al. demonstrate a functional equivalence between fully embedding non-adhesive material forms and partially embedding material forms (compare Fig. 1 of Calhoun et al. and Fig. 2B of Rusincovitch et al.). Both adhesive substrates in the aforementioned references achieve the same end result with regards to repositionability and slidability. Whether the Applicant views the teachings of Rusincovitch et al. as teaching non-adhesive material forms partially or fully embedded, the positioning of the non-adhesive material forms still perform the same function whether or not they are fully embedded or partially embedded. Therefore, depending on the desired end product and in the absence of any unexpected results, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have positioned the non-adhesive material forms in any functionally equivalent fashion (i.e. partially or fully embedded). Furthermore, it would have been obvious to arrange the non-adhesive material forms such that they are at or below the surface of the release liner since it has been held that rearranging parts of an invention involves only routine skill in the art, absent a demonstration of unexpected results. In re Japikse, 86 USPQ 70. Again, just as it would have been obvious to reposition a starting switch on a hydraulic power press since it would not have modified the operation of the device, repositioning

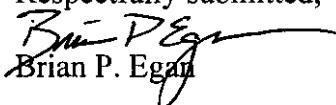
of the non-adhesive material forms within the release liner still results in the same end product – an adhesive substrate with protruding non-adhesive forms that assist in slidability and repositionability of the substrate. The mere fact that Rusincovitch et al. improve upon the teachings of Calhoun et al. does not preclude one of ordinary skill in the art from concluding that it is known to both fully and partially embed non-adhesive material forms into a release liner such that the adhesive substrate achieves a desired level of repositionability.

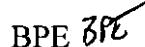
Third, with regards to independent claim 60 and the teachings of Calhoun et al. (U.S. 5,141,790) in view of Torobin (U.S. 4,582,534), the Applicant's primary contention is that microspheres with sputtered or vacuum metallized non-adhesive material forms that line glass microspheres are not "deposits" of metallized non-adhesive material forms. The Examiner respectfully disagrees. By amending the claim language to include the word "deposits" does not preclude the use of glass microspheres whose surface comprises "deposits" of metallized non-adhesive material forms. Whether the glass microspheres comprise the deposits or whether the deposits are vacuum metallized or sputtered directly onto or embedded into the release liner, the teachings of Calhoun and Torobin still read on the Applicant's claimed invention. The microspheres are embedded into the surface of the release liner, and therefore, the metallized deposits on the microspheres would also be embedded into the release liner. The Applicant does not explicitly define the sputtering or vacuum metallization processes and only makes note of them in paragraphs [0053] and 0055] of the specification. Therefore, the Examiner must interpret both "vacuum metallized" and "sputtered" in their broadest possible sense. Given not only that Torobin teaches a vacuum microsphere with a metal coating lining the inside of the sphere, but also teaches that the metal can be blown through a blowing nozzle and subsequently

cooled such that it deposits along the microsphere, the formation processes of Torobin broadly encompass both sputtering and vacuum metallization techniques. Since the use of a metallized or sputtered surface in combination with microspheres provides a substrate with microspheres superior in strength while light in weight (Torobin, Col. 2, lines 5-11), there is clear motivation to modify Calhoun et al. to include a metallized surface in order to achieve superior light weight and strength properties.

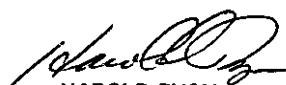
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Brian P. Egan

BPE 
May 24, 2004

Conferees
Harold Pyon 
Deborah Jones 


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/24/04

Heidi A. Bochlefeld
Renner, Otto, Boisselle & Sklar, P.L.L.
Nineteenth Floor
1621 Euclid Avenue
Cleveland, OH 44115